

Remarks/Arguments

Claims 16-25 are pending in this application, and are rejected in the final Office Action of April 28, 2009. No claim amendments are presented herein. However, a listing of the pending claims accompanies this response for the Examiner's convenience.

Re: Patentability of Claims 16-18, 20, 22 and 24 under 35 U.S.C. §103(a)

Claims 16-18, 20, 22 and 24 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,850,218 issued to LaJoie et al. (hereinafter, "LaJoie"). Applicants respectfully traverse this rejection for at least the following reasons.

At the outset, Applicants again note that the claimed invention addresses and solves a general problem related to how to provide coordination between performing program purchases and program recordings. In particular, the claimed invention addresses two specific situations where coordination between performing program purchases and program recordings is needed.

The first situation occurs when a user selects a program for both purchase and recording, and **later** decides to cancel the purchase. The solution to the problem in this first situation is defined by independent claims 16, 18 and 22. In particular, independent claims 16, 18 and 22 define a method/apparatus in which a program (i.e., the "second program") is automatically removed from a list of programs scheduled for recording (i.e., the "first list") in response to user removal of the program from a list of programs selected for purchase (i.e., the "second list").

The second situation occurs when a user selects a program for both purchase and recording, and **later** decides to cancel the recording. The solution to the problem in this second situation is defined by independent claims 17, 20

and 24. In particular, independent claims 17, 20 and 24 define a method/apparatus in which an on screen display option is provided so that a user is afforded an opportunity to cancel the purchase of a program in response to the user canceling a scheduled recording of the program.

On pages 5-6 of the final Office Action dated April 28, 2009, the Examiner admits that LaJoie fails to disclose all of the elements of independent claims 16-18, 20, 22 and 24. However, the Examiner alleges that a “conflict checking feature” of LaJoie serves as the basis for rendering claims 16-18, 20, 22 and 24 obvious under 35 U.S.C. §103(a). Applicants respectfully disagree.

As previously pointed out by Applicants, the aforementioned “conflict checking feature” of LaJoie specifically addresses only a limited number of conflict situations. In particular, in describing the types of conflicts that may arise, LaJoie states:

“Conflicts can arise, for example, when there are overlapping timers, unusual settings (such as VCR record timers which exceed typical tape length), record timers for unpurchased Impulse Pay-Per-View (IPPV) events, attempts to set up more than a limiting number of VCR timers (e.g., eight), and attempts to purchase more than a limiting number of IPPV events (e.g., eight).” (see column 21, lines 35-42)

As indicated above, LaJoie expressly describes only a limited number of conflict situations. Moreover, and most significantly, LaJoie fails to even recognize the two specific situations described above which are addressed by the claimed invention. That is, LaJoie fails to address the first situation where a user selects a program for both purchase and recording, and later decides to cancel the purchase. Moreover, LaJoie fails to address the second situation where a user selects a program for both purchase and recording, and later

decides to cancel the recording. As such, LaJoie fails to recognize and address the two specific problems that are solved by the claimed invention.

Given that LaJoie fails to even recognize the two specific problems that are solved by the claimed invention, it's not surprising that the reference also fails to disclose or suggest the solutions defined by independent claims 16-18, 20, 22 and 24, or the desirability thereof. Here, Applicants again note that the mere fact that a prior art device could (in hindsight) be modified to produce a claimed invention is not a basis for an obviousness rejection unless the prior art suggests the desirability of such a modification. See, for example, *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989) ("Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to the form the [claimed] structure, '[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.'") and *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In this case, Applicants maintain that LaJoie fails to teach or suggest the desirability of the solutions defined by independent claims 16-18, 20, 22 and 24.

Moreover, Applicants submit that there is no apparent reason that one of ordinary skill in the art would even attempt to modify the teachings of LaJoie in the manner proposed by the Examiner, see *KSR Int'l v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-41 (2007). This is particularly evidenced by the facts pointed out above in that LaJoie fails to even recognize the two specific situations, and associated problems, which are addressed and solved by the claimed invention. That is, LaJoie fails to recognize a situation where a user selects a program for both purchase and recording, and later decides to cancel the purchase, and also fails to recognize a situation where a user selects a program for both purchase and recording, and later decides to cancel the recording. As such, Applicants submit that the Examiner's application of the Graham factors is clearly based on

impermissible hindsight based on teachings gleaned from the Applicants' disclosure, and from improperly filling-in the missing gaps of the prior art in an attempt to meet the elements of the claimed invention.

Accordingly, for at least the foregoing reasons, Applicants submit that claims 16-18, 20, 22 and 24 are patentable over LaJoie under 35 U.S.C. §103(a), and withdrawal of the rejection is respectfully requested.

Re: Patentability of Claims 19, 21, 23 and 25 under 35 U.S.C. §103(a)

Claims 19, 21, 23 and 25 are rejected under 35 U.S.C. §103(a) as being unpatentable over LaJoie in view of the RCA DRD202RA Owner's Manual (hereinafter, "the RCA manual"). Applicants respectfully traverse this rejection for at least the following reasons. The RCA manual fails to remedy the deficiencies of LaJoie discussed above in conjunction with independent claims 16-18, 20, 22 and 24, from which claims 19, 21, 23 and 25 depend. Accordingly, claims 19, 21, 23 and 25 are deemed patentable over the proposed combination of LaJoie and the RCA manual under 35 U.S.C. §103(a), and withdrawal of the rejection is respectfully requested.

Conclusion

In view of the foregoing remarks/arguments, Applicants believe that this application stands in condition for allowance. Accordingly, reconsideration and allowance are respectfully solicited. If, however, the Examiner is of the opinion that such action cannot be taken, the Examiner is invited to contact the Applicants' attorney at (609) 734-6813, so that a mutually convenient date and time for a telephonic interview may be scheduled. No fee is believed due. However, if a fee is due, please charge the fee to Deposit Account 07-0832.

Respectfully submitted,
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